

U.S. Patent Application Serial No. 10/725,390  
Attorney Docket No. 11952-4 KAM

**In the Drawings:**

Please replace Figures 8 and 9 with Figures 8 and 9 attached hereto.

U.S. Patent Application Serial No. 10/725,390  
Attorney Docket No. 11952-4 KAM

### REMARKS

Claims 2-4, 10, 11, 13-23, 25, 29-49 and 51 are pending. Claims 1, 5-9, 12, 24, 26-29 and 50 have been cancelled without prejudice.

The Specification has been amended to include a paragraph claiming the benefit of U.S. provisional application Serial No. 60/430,688, filed December 3, 2003, entitled "A FLOW-REGULATING DEVICE". The Specification and Drawings have also been amended to correct a reference numeral; the "end" is now represented by reference numeral 75 rather than reference numeral 74.

Claim 15 has been re-written in independent form including all of the limitations of the base claim and any intervening claims.

Claims 18, 22, 23 and 25 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 25 has been re-written in independent form including all of the limitations of the base claim and any intervening claims.

The claims have been appropriately re-numbered. In particular, claims 37 (2<sup>nd</sup> occurrence) to 46 have been re-numbered as claims 38-47, respectively.

Claims 2-4, 10, 11, 13, 14, 16, 18, 19, 31-36, 42 (now claim 43), 43 (now claim 44), 48 and 49 have been amended to be properly dependent in view of the amendments to claims 15 and 25.

Claim 51 has been added and is fully supported by the specification as originally filed.

### Specification

The Office Action objects to the disclosure because of the following informalities: on page 6, line 30, reference number 74 is referred to as the "head" and then on page

U.S. Patent Application Serial No. **10/725,390**  
Attorney Docket No. **11952-4 KAM**

7, line 4, reference number 74 is referred to as the "end". Page 7 of the Specification and Figures 8 and 9 of the Drawings have been amended to refer to reference numeral 75 rather than reference numeral 74.

**Claim Objections**

The Office Action objects to claims 37 and 37 (2<sup>nd</sup> occurrence) because two claims have the same claim number. The Office Action also notes that there is no claim 47. The claims have been appropriately re-numbered. In particular, claims 37 (2<sup>nd</sup> occurrence) to 46 have been re-numbered as claims 38-47, respectively.

**Claim rejections-35 U.S.C. §112**

Claim 17 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The housing is defined in claim 16 as "at least about 10.2 cm" and then it is further defined in claim 17 as "about 10.2 cm". The Office Action asserts that the limitation of claim 17 is broader than the limitation of claim 16 since the limitation of claim 17 could include measurements less than 10.2 cm. The Office Action further asserts that the limitation of claim 17 does not further limit Applicant's claimed invention. Applicant respectfully disagrees. The housing length defined in claim 16 as "at least about 10.2 cm" (emphasis added) includes "about 10.2 cm" or a length greater than that amount. Claim 17 is simply referring to the embodiment of "about 10.2 cm", which is fully encompassed within claim 16.

**Claim rejections-35 U.S.C. §102(b)**

Claims 1-10, 12-14, 24, 26-34, 37-40, 42-45, 49 and 50 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,410,517 to Wall for the reasons outlined in the Office Action.

U.S. Patent Application Serial No. 10/725,390  
Attorney Docket No. 11952-4 KAM

Each of claims 15 and 25 has been re-written in independent form including all of the limitations of the base claim and any intervening claims. The remaining pending claims have been amended to ultimately depend upon claim 15 or claim 25. Since the Office Action has allowed claim 25, if re-written in independent form including all of the limitations of the base claim and any intervening claims, and since claim 15 is not anticipated by Wall, it is respectfully submitted that claims 15 and 25, and claims dependent therefrom, are patentable over Wall.

**Claim rejections-35 U.S.C. §103(a)**

Claims 15 and 19-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,410,517 to Wall in view of U.S. Patent No. 3,675,656 to Hakim. The Office Action asserts that Wall describes the regulating valve comprising a two-piece housing (11 and 15) of the claimed invention. The Office Action admits that Wall fails to disclose or suggest a one piece housing with a longitudinal slot and a curved housing. The Office Action asserts, however, that Hakim teaches a regulating valve comprising a housing (14, 18, 20 and 22) having a compression member (28), the housing having a longitudinal slot (the space between element 22 and 24), and the housing being curved between 135 degrees and 180 degrees (Figure 4).

The Office Action concludes, therefore, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the regulating valve having a two-piece housing of Wall by making it a one piece housing with a longitudinal slot as taught by Hakim in order to reduce the required number of parts so that the cost of the regulating valve is decreased and to make it easier for the regulating valve to be used by just inserting the hose into the valve without opening the housing (Col. 1, lines 18-23).

It is respectfully submitted that claims 15 and 19-21, which are now ultimately dependent upon claim 15, are patentable over the applied art of record for the following reasons.

U.S. Patent Application Serial No. 10/725,390  
Attorney Docket No. 11952-4 KAM

Firstly, in order to rely on a reference under 35 U.S.C. §103, the reference must be analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned". *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). It is submitted that U.S. Patent No. 3,675,656 to Hakim would not have commended itself to the inventor's attention in considering regulating the flow of fluid through a hose, such as a garden hose, of the present invention. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), "Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments." Applicant submits that Hakim was not within the field of Applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned since a person of ordinary skill, seeking to solve a problem of regulating the flow of fluid through a hose, such as a garden hose, would not reasonably be expected or motivated to look to a hemostat for controllably occluding a blood vessel.

Secondly, in order to establish *prima facie* obviousness, there must be some

U.S. Patent Application Serial No. **10/725,390**  
Attorney Docket No. **11952-4 KAM**

suggestion or motivation, either in the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. See M.P.E.P. §2143 and §2143.01. With respect to Wall, Wall teaches that their water regulator has a top shell unit 11 and a bottom shell unit 15, wherein abutting inserts 16 and 17 are positioned in top shell unit 11 and bottom shell unit 15, respectively (emphasis added) to completely encircle the hose. In addition, cooperating lugs 19 and 20 house the locking mechanism of the water regulator to maintain the water regulator in a closed position. Consequently, Wall teaches that their water regulator must completely encircle the hose by utilizing abutting inserts and a lock. Hence, a person of ordinary skill would not be motivated to combine the teachings of Wall with Hakim since Hakim teaches away from using a device that would completely encircle the hose.

Thirdly, Applicant submits that Hakim does not teach or suggest that the longitudinal slot is large enough for the hose to pass therethrough but small enough for the hose to be retained within the channel during use, as claimed in claim 15 of the present application.

Fourthly, Applicant submits that "hindsight" is being used in determining obviousness. The Supreme Court has frequently warned against the use of "hindsight" in determining obviousness (see for example *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428 (1911)). As noted in *re Mahurkar Patent Litigation* (1993) 831 F. Supp. 1354, 28 U.S. PQ 2d 180 (N.D. ILL. 1993.), Judge Easterbrook noted that "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex post analysis".

For these reasons, Applicant submits that the cited references, Wall and Hakim, do not teach or suggest the invention of claims 15 and 19-21, wherein claims 19-21 are ultimately dependent upon claim 15.

U.S. Patent Application Serial No. 10/725,390  
Attorney Docket No. 11952-4 KAM

Claims 11, 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,410,517 to Wall. Claims 11, 16 and 17 are now ultimately dependent upon claim 15. Applicant submits that Wall does not teach or suggest the device of claim 15. As discussed above, the Office Action admits that Wall fails to disclose or suggest a one-piece housing with a longitudinal slot. Consequently, since claims 11, 16 and 17 are now ultimately dependent upon claim 15, these claims are not rendered obvious in view of Wall.

Claims 35, 36, 41, 46 and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,410,517 to Wall in view of U.S. Patent No. 3,285,563 to Clarkson. Claim 35 is now dependent upon claim 25 and claims 36, 41, 46 and 47 are now ultimately dependent upon claim 15.

Since the Office Action has allowed claim 25, as re-written in independent form including all of the limitations of the base claim and any Intervening claims, claim 35 is not rendered obvious in view of Wall and Clarkson since claim 35 depends from claim 25.

Applicant submits that Wall does not teach or suggest the device of claim 15. As discussed above, the Office Action admits that Wall fails to disclose or suggest a one-piece housing with a longitudinal slot. Since Clarkson does not teach or suggest the longitudinal slot as claimed in claim 15, Applicant submits that Wall, in combination with Clarkson, does not teach or suggest the invention of claim 15. Consequently, since claims 36, 41, 46 and 47 are now ultimately dependent upon claim 15, these claims are not rendered obvious in view of Wall and Clarkson.

Claim 48 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,410,517 to Wall in view of U.S. Patent No. 5,098,060 to Mogler *et al.* Claim 48 is now dependent upon claim 15.

Applicant submits that Wall does not teach or suggest the device of claim 15. As discussed above, the Office Action admits that Wall fails to disclose or suggest a one-piece housing with a longitudinal slot. Since Mogler *et al.* does not teach or suggest the

U.S. Patent Application Serial No. 10/725,390  
Attorney Docket No. 11952-4 KAM

longitudinal slot as claimed in claim 15, Applicant submits that Wall, in combination with Mogler *et al.*, does not teach or suggest the invention of claim 15. Consequently, since claim 48 is ultimately dependent upon claim 15, this claim is not rendered obvious in view of Wall and Mogler *et al.*

### **Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of claims 2-4, 10, 11, 13-23, 25, 29-49 and 51, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Sim & McBurney's Deposit Account No. 192253, referencing docket number 11952-4 KAM.

Respectfully submitted,

**SIM & McBURNEY**



Kimberly A. McManus, Ph.D.  
Agent for Applicant  
Registration No. 54,791

Customer No. 24223  
330 University Avenue, 6<sup>th</sup> Floor  
Toronto, Ontario  
Canada M5G 1R7  
Telephone: 416-595-1155 (x297)  
Facsimile: 416-595-1155